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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YOUJI KOHDA,
SOICHI NISHIYAMA,
KOICHI MURAKAMI, and
TAKAYA FUJITA

Appeal 2009-006262
Application 09/766,646
Technology Center 3600

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
FRANCISCO C. PRATS, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Youji Kohda et al. (Appellants) seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1-12 and 14-26. We have jurisdiction under 35 U.S.C. § 6(b) (2002). Claim 13 has been canceled.

SUMMARY OF DECISION

We REVERSE.²

THE INVENTION

This invention is “technology for promoting the sale of products and services posted on a company web site over the Internet.” Specification 1:5-9.

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. An online sales promotion method used in a system to purchase a product over a network, said method comprising:
 - associating cart identification information with a first user;
 - receiving, from the first user, designation information of a third party product provider which the first user permits to view the cart identification information and to view product information which the first user associates with the cart identification information, and which provides a product related to the viewed product

² Our decision will make reference to the Appellants’ Appeal Brief (“App. Br.,” filed Sep. 12, 2008) and Reply Brief (“Reply Br.,” filed Dec. 30, 2008), and the Examiner’s Answer (“Answer,” mailed Oct. 30, 2008).

information as well as additional information related to the viewed product information, said third party product provider not having permission to view the cart identification and product information before receipt of the designation information;

associating and storing the designation information with the cart identification information;

receiving product information on said product from the first user;

associating said product information with the cart identification information;

notifying said third party product provider associated with said cart identification information of said cart identification information and product information in accordance with a receipt of designation information of said third party product provider or a receipt of said product information;

receiving additional information regarding the product identified by said product information, and the cart identification information, from said third party product provider;

determining whether the received additional information is from the third party product provider which the first user permits to view the cart identification information and to view the product information associated with the cart identification information;

associating said received additional information with said cart identification information according to the determination result; and

notifying said first user of said received product information and additional information.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Hunt	US 6,223,215 B1	Apr. 24, 2001
Notz	US 7,016,864 B1	Mar. 21, 2006
Allibhoy	US 2004/0172343 A1	Sep. 2, 2004
Hoyle	US 2005/0005242 A1	Jan. 6, 2005

The following rejections are before us for review:

1. Claims 1, 6-10, and 23-26 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.
2. Claims 1-12 and 14-26 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hunt, Hoyle, Allibhoy and Notz.

ISSUES

The first issue is whether claims 1, 6-10, and 23-26 are directed to non-statutory subject matter under 35 U.S.C. §101. Specifically, the issue is whether claims 1, 6-10, and 23-26 recite patent eligible processes or abstract ideas.

The second issue is whether claims 1-12 and 14-26 are unpatentable under 35 U.S.C. §103(a) over Hunt, Hoyle, Allibhoy and Notz. Specifically, the issue is whether Allibhoy teaches a third party product provider not having permission to view the cart identification and product information before receipt of the designation information.

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

Allibhoy

1. Allibhoy describes a system that broadcasts enhanced content programming, such as purchasing information for a product currently being shown. Allibhoy [0066].
2. Allibhoy describes content providers broadcasting enhanced content programming to a user's receiver (Allibhoy [0066]), via an ATV controller (Allibhoy [0069]).
3. Allibhoy describes that the enhanced content programming includes triggers or markers that can include a content provider indicator. Allibhoy [0137].
4. Allibhoy describes that the triggers are used to filter from the stream on enhanced content programming the material which is of interest to a user. Allibhoy [0140]. *See also* Allibhoy [0157] – [0162].
5. Allibhoy's paragraph [0159] states:

In at least one embodiment of the invention, as illustrated in FIG. 12, a trigger information filter is defined (step 1201), either explicitly by the user or implicitly by the user's profile. Preferably the information filter is explicitly set, thus allowing the user to change the filter frequently depending upon current needs. Once set, ATV controller 109

monitors all possible sources, including both those associated with the channel being viewed and those associated with other channels, for triggers meeting the criteria (step 1203). Once a trigger meeting the criteria is detected, the user is notified (step 1205), typically using a screen graphic or an audible signal. Alternatively, the system can be configured to immediately present the user with any information meeting the preset criteria (step 1207).

6. Allibhoy is silent as to whether or not enhanced content programming is received by the user prior to the filters being set.

Notz

7. Notz describes online store that has an upsell advisor included in a shopping cart. Col. 4, ll. 35-48.
8. Notz describes that the upsell advisor uses information from the shopping card to recommend an upsell to the customer. *See* col. 5, ll. 45-61 and col. 6, ll. 22-28 and 43-46.
9. Notz describes that after the upsell advisor operates to obtain information about the items in the shopping cart, “an inquiry is made as to whether or not the given customer store allows for the upsell advisor.” Col. 10, ll. 25-37. *See also* Fig. 5.

ANALYSIS

The rejection of claims 1, 6-10, and 23-26 as being directed to non-statutory subject matter under 35 U.S.C. §101

The Examiner rejected claims 1, 6-10, and 23-26 under 35 U.S.C. § 101 as being directed to non-statutory subject matter because the method

was not tied to another statutory class of invention (such as a particular apparatus) or transform the underlying subject matter (such as an article or materials). Answer 24-25. The Examiner seems to have found that these claims fail the machine-or-transformation test. *Id.*

Notwithstanding that this test for determining patent eligibility of a process is unduly narrow (*see Bilski v. Kappos*, 130 S. Ct. 3218, No. 08-964, 2010 WL 2555192 (U.S. June 28, 2010)), it can nevertheless be instructive as a factor in determining whether the claimed processes are patent-ineligible abstract ideas.

Before we can determine whether the claimed processes are abstract ideas, the broadest reasonable construction of the claims must first be established. *See State St. Bank & Trust Co. v. Signature Fin. Group*, 149 F.3d 1368, 1370 (Fed. Cir. 1998) (“whether the . . . patent is invalid for failure to claim statutory subject matter under 35 U.S.C. § 101[] is a matter of both claim construction and statutory construction”). In that regard, the claims recite “cart identification information,” which reasonably construed seems to implicitly require an electronic shopping cart, which would require a particular apparatus.

The Examiner finds that the claimed processes are not tied to another statutory class of invention, such as a machine. But the Examiner does not explain why this is so. *See* Answer 24-25. An explanation is made more necessary, given that the claims are reasonably broadly construed to require a particular apparatus. That is, they are nominally tied to a particular apparatus in contradistinction to the Examiner’s finding. The initial burden of establishing that the claimed processes are patent-ineligible abstract ideas has not therefore been established because the construction of the claims

does not fully support finding that they are not tied to an apparatus as an underlying factor in concluding that the processes as claimed as a whole are patent-ineligible abstract ideas.

Accordingly, we find that the rejection of claims 1, 6-10, and 23-26 under 35 U.S.C. § 101 as being directed to non-statutory subject matter is overcome.

The rejection of claims 1-12 and 14-26 under §103(a) as being unpatentable over Hunt, Hoyle, Allibhoy, and Notz.

Method Claims 1-10, 14-20, and 23-26

Claim 1 recites:

receiving, from the first user, designation information of a third party product provider which the first user permits to view the cart identification information and to view product information which the first user associates with the cart identification information, and which provides a product related to the viewed product information as well as additional information related to the viewed product information, *said third party product provider not having permission to view the cart identification and product information before receipt of the designation information.*

(Emphasis added.)

The Appellants argue that none of Hunt, Hoyle, Allibhoy, and Notz, teaches the limitation above. App. Br. 21-28 and Reply Br. 4-9. Specifically, the Appellants argue that the Examiner has mischaracterized the teaching of Allibhoy and that Allibhoy does not teach the limitation above. Reply Br. 6-8.

The Examiner relies upon Allibhoy's description of a user setting a filter for enhanced content programming to teach receiving designation information of a third party product provider. Answer 29. The Examiner reasons that the filter could be set to filter the enhanced content programming broadcast for content from content providers meeting the user's criteria. Answer 29-31. The Examiner asserts that the content providers that meet the user's criteria are allowed to interact with the user (i.e. their content passes the filter) and those that do not are not allowed to interact with the user. *Id.* The Examiner seems to assume, though not explicitly, that prior to the filters being set by the user content providers are not allowed to interact with the user. Citing paragraph [0159] (*see* FF 5), the Examiner states: "Allibhoy further discloses allowing the third party product providers to send content to the user *only after* receiving permission from the user . . ." Answer 29 (emphasis added). The Examiner also states: "Hence, Allibhoy discloses allowing the third party product providers to send content to the user *only after* receiving permission from the user." Answer 30 (emphasis added).

However, while Allibhoy does teach that, after the filters are set, only certain enhanced content is passed to the user (*see* FF 4-5), Allibhoy is silent as to whether or not enhanced content programming is received by the user prior to filters being set by the user. FF 6. For example, prior to a user setting the filter, all enhanced content programming could pass to the user, or no enhanced content programming could pass to the user.

Moreover, while the user or network operator of Allibhoy's system may filter the information transmitted to the user (*see, e.g.,* Allibhoy [0003], [0054], [0159]), the Examiner has not adequately explained why the cited

portions of Allibhoy teach or suggest that the filters actually deny the content provider permission to access the user's purchase information, i.e. cart identification information, as the claims require. Therefore, we disagree with the Examiner that Allibhoy discloses allowing the third party product providers (i.e. content providers) to interact with the user *only after* receiving permission from the user (i.e. user setting the filter).

Further, we note that Notz, which the Examiner cites to teach a third party viewing cart identification information (Answer 33-34), also does not teach the limitation at issue. In Notz, the upsell advisor sees the cart information prior to receiving permission to offer an upsell or not. FF 8-9. We find that neither the cited teachings of Allibhoy, relied upon by the Examiner, nor Notz teaches the limitation at issue.

Independent claims 14 and 23 also recite steps similar to the one at issue above, and our reasoning applies equally to the rejection of those claims. Accordingly, we find that the Appellants have overcome the rejection of claims 1-10, 14-20, and 23-26 under 35 U.S.C. §103(a) as being unpatentable over Hunt, Hoyle, Allibhoy, and Notz.

Apparatus Claims 11 and 21

Claim 11

Unlike claim 1 discussed above, claim 11 is directed to an apparatus that includes limitations written in means-plus-function format.

35 U.S.C. § 112, paragraph 6:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to

cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Construing means-plus-function claim language in accordance with 35 U.S.C. § 112, paragraph 6, is a two step process.

The first step in construing a means-plus-function claim limitation is to define the particular function of the claim limitation. *Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1376 (Fed.Cir.2001). “The court must construe the function of a means-plus-function limitation to include the limitations contained in the claim language, and only those limitations.” *Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 296 F.3d 1106, 1113 (Fed.Cir.2002). . . . The next step in construing a means-plus-function claim limitation is to look to the specification and identify the corresponding structure for that function. “Under this second step, ‘structure disclosed in the specification is “corresponding” structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim.’ ” *Med. Instrumentation & Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1210 (Fed.Cir.2003) (quoting *B. Braun Med. Inc. v. Abbott Labs.*, 124 F.3d 1419, 1424 (Fed.Cir.1997)).

Golight Inc. v. Wal-Mart Stores Inc., 355 F.3d 1327, 1333-34 (Fed. Cir. 2004).

Claim 11 recites a means for the receiving step at issue above.

The Appellants assert that computer 3, which has a stored program for performing the recited function, is the structure in the Specification that corresponds to the recited means for receiving designation information. App. Br. 10. For the same reasons as discussed above, with regards to claim 1, we find that the Examiner has not established that either Allibhoy or Notz teaches this corresponding structure or an equivalent. Accordingly, we find

that the Appellants have overcome the rejection of claim 11 under 35 U.S.C. § 103(a) as being unpatentable over Hunt, Hoyle, Allibhoy, and Notz.

Claim 21

Claim 21 recites a first acceptance unit that performs a function similar to the step at issue above with regard to claim 1. For the reasons, discussed above, we find that the Examiner has not established that the combination of Hunt, Hoyle, Allibhoy, and Notz teaches a first acceptance unit that is capable of performing the recited function. *Cf. In re Schreiber*, 128 F.3d 1473, 1477-78 (Fed. Cir. 1997) (functional language does not confer patentability if prior art structure has capability of functioning in the same manner). Accordingly, we find that the Appellants have overcome the rejection of claims 1-10, 14-20, and 23-26 under 35 U.S.C. §103(a) as being unpatentable over Hunt, Hoyle, Allibhoy, and Notz.

Article Claims 12 and 22

Both claims 12 and 22 recite a computer-readable recording medium storing a program to perform a step similar to that at issue in claim 1 above. For the reasons discussed above, we find that the Examiner has not established that the combination of Hunt, Hoyle, Allibhoy, and Notz teaches a computer-readable recording medium storing a program to perform the recited step. Accordingly, we find that the Appellants have overcome the rejection of claims 12 and 20 under 35 U.S.C. §103(a) as being unpatentable over Hunt, Hoyle, Allibhoy, and Notz.

DECISION

The decision of the Examiner to reject claims 1-12 and 14-26 are reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

REVERSED

mev

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